

REMARKS

Claims 1-14 are pending in this application. Claims 1-5, 7, and 10-13 stand rejected and claims 6, 8, 9, and 14 are objected to.

Applicant wishes to thank the Examiner for the indication of allowable subject matter in claims 6, 8, 9, and 14. In light of the remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance. Applicant defers rewriting these claims in independent form until final resolution of the independent claims from which these claims depend.

Paragraphs 2-4 reject claims 1, 3, 4, 7, 10, and 13 under 35 U.S.C. § 103(a) as being unpatenable over Keskitalo in view of Kijima. Applicant respectfully requests reconsideration and withdrawal of this rejection.

Simply because information is well known does not make it obvious to combine that information with any reference. The Office Action must explain the reasons why one of ordinary skill in the art would be motivated to select the references or teachings and combine them. In re Rouffet, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998). A principle must be identified, known by those with ordinary skill in the art, that suggests the claimed invention. Id. Inventions are frequently the process of combining prior art in a nonobvious manner. Id.

To properly reject the Applicant's claims for obviousness in view of a combination of prior art references, the Office Action must establish that a person of ordinary skill in the art would have been motivated to combine the

cited references and, in combining them, would have arrived at the invention claimed by the Applicant. In re Kotzab, 208 F.3d 1365, 1370 (Fed. Cir. 2000). A motivation to combine may arise from: (i) either explicit or implicit statements in the prior art references themselves; (ii) the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or (iii) the nature of the problem to be solved. Ruiz v. A.B. Chance Co., 234 F.3d 654, 665 (Fed. Cir. 2000).

Regardless of its source, or the form that it takes, a motivation to combine must be clearly and particularly shown. In re Dembiczak, 175 F.3d 994, 999-1000 (Fed. Cir. 1999). The Federal Circuit has held that a motivation to combine is not shown by the mere assertion that the claimed invention would have been obvious to one of ordinary skill in the art simply because it is a combination of elements that were known at the time of the invention:

[T]here is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention. See, Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed.Cir.1985). Instead, the relevant inquiry is whether there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the references, and that would also suggest a reasonable likelihood of success. See, e.g., In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed.Cir.1988).

Smiths Indus. Medical Systems Inc. v. Vital Signs, Inc., 183 F.3d 1347, 1356 (Fed. Cir. 1999); see also In re Dembiczak, 175 F.3d at 999-1000 (Fed. Cir. 1999).

The Office Action's sole justification for combining Keskitalo and Kijima in the rejection of independent claims 1 and 10 is precisely the sort of assertion that the Federal Circuit rejected in Smith. The Office Action argues that one of skill in the art would arrange the antenna elements described by Keskitalo in a polygon arrangement as discussed by Gordon, as arranging antenna elements in this type of configuration as well in the art in order to project clearer signals in multiple sides. See Office Action, at 3. This assertion, however, is merely conclusory and in fact, Kijima does not relate at all to clearer signals on multiple sides. The simple statement that the combination of Keskitalo and Kijima would yield the claimed invention does not say how or why a person of ordinary skill in the art would be motivated to modify the arrangement of components of Keskitalo in light of Kijima. In Fact, the Office Action implies that one would modify Keskitalo in light of Kijima because of the disclosure in Gordon. However, Gordon is not included in the rejection of claims 1, 3, 4, 7, 10 and 13. Further, the cited portion of Kijima teaches away from combining Keskitalo and Kijima. Applicant's claims require M elements that form a directional pattern. Kijima criticizes multibeam antenna devices that require the same number of faces as beams. Thus, even if one were to assume that Gordon provides some motivation to combine, which it does not, one skilled in the art would not use the active design *criticized* in column 1 of Kijima.

Thus, claims 1 and 10 are allowable over the cited combination because one skilled in the art would not combine those references.

In summary, the Office Action fails to establish with clarity and particularity that a person of ordinary skill in the art would be motivated to change the arrangement of components disclosed in Keskitalo in light of Kijima. As a result, the Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of obviousness with respect to claims 1 and that the objection to those claims under Section 103 should be withdrawn.

The Office Action has failed to show a motivation in the cited references for combining the functioning of the antenna array in Keskitalo with the arrangement criticized in Kijima. See M.P.E.P. § 2143. Absent a showing of such a motivation, a *prima facie* case of obviousness cannot be made. As such, if the Examiner persists in stating that such motivation is known, Applicant requests that the Examiner set forth a reference which shows such a motivation or that the Examiner submit an Examiner's affidavit indicating that such knowledge is known by one of ordinary skill in the art and that one with ordinary skill in the art would be motivated to combine such knowledge with Saints so that Applicant has the opportunity to rebut such an assertion. See M.P.E.P. § 2144.03.

Claims 2-9 and 11-14 depend from, and contain all the limitations of either claim 1 or 10. These dependent claims also recite additional limitations which, in combination with the limitations of claim 1 or 10, are neither disclosed

nor suggested by the disclosed references and are also directed towards patentable subject matter. Thus, claims should also be allowed.

Applicant has responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

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Respectfully submitted,

By


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